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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,707	12/21/2001	Nozomi Sawada	217575US2	6876

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EXAMINER

BRAUN, FRED L

ART UNIT PAPER NUMBER

2852

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/023,707

Applicant(s)

SAWADA, NOZOMI

Examiner

Fred L. Braun

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-15 and 18-21 is/are rejected.
- 7) ☒ Claim(s) 7,8,16 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
2. The abstract of the disclosure is objected to because it (1) uses the legal phraseology "means"; (2) fails to set forth a concise statement of what applicant considers to be his contribution to the art to which the invention pertains since the present abstract merely sets forth that which is already known in the art as evidenced by the prior art cited hereinbelow; and (3) fails to mention the fact that a method also formed a part of applicant's contribution to the art. 3.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

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The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 9-15 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hube et al.

It is submitted that all of the claimed structure of the image forming apparatus and the image forming method steps, respectively, recited in claims 1-6, 9-15 and 18-21 of the subject application are obvious to one having ordinary skill in the art upon perusal of column 3, line 28 through column 9, line 20 of Hube et al. More specifically element 56(Fig 2) of Hube et al is the storage means for storing setting and/or reading means for reading, respectively, information including at least a size of substitute recording medium, as recited in claims 1 and 10, respectively, for example; and elements 54, 60 (Fig 2) of same the processing means and/or processing step, respectively, for execution a print instruction by automatically changing a size of a recording medium to be used to the size of the substitute recording medium when the size specified by the print instruction is not available, (column 7, line 30 through column 8, line 45), as also recited in base claims 1 and 10 respectively, for example. With respect to claims 2 and 11, respectively, it is submitted that Figure 5 of Hube et al suggests to one having ordinary skill in

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the art whether or not a zoom is required since the input touch screen 62 (Fig 5) of same has an icon thereon which enables an operator to instruct whether or not the document being reproduced should be reduced or enlarged in size. Elements 90-1, 90-2, 90-3 of Hube et al is considered to be the means for storing the setting information in the storage means, as recited in claims 3 and 12, respectively; elements 64, 66 of same the setting means for setting and storing the setting information in the storage means, as recited in claims 5 and 14, respectively; and element 200 (Figs 6A and 6B) of same is the storage means in the form of a table, recited in claims 6 and 15, respectively. As to claims 9 and 18, respectively, it is submitted that the job ticket 150 (Fig 4) of Hube et al has an account number thereon which is considered to be the full equivalent of the user ID recited in claims 9 and 18, respectively (column 6, lines 6-29). It is further submitted that it is obvious to one having ordinary skill in the art that the computer program disclosed by Hube et al will perform the reading procedure and processing procedure, respectively, recited in base claim 19; the registering procedure, recited in base claim 20; and that the computer program is within a host unit 5 (Fig 2) and within a computer 54 (Fig 2) within the image forming apparatus as recited in claim 21.

8. The patents to De Horthy, Kimoto et al, Bunker et al, Mizude et al, Sato and Rikima, respectively, are cited of interest to further show the obviousness of providing an image forming apparatus with a computer program means for determining whether or not an appropriate size of

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a substitute sheet of paper is available for the print job when the size of paper initially selected is not available.

9. Claims 7, 8, 16 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication should be directed to Fred L Braun at telephone number (703) 308-0128.

*Fred L Braun*  
FRED L BRAUN  
PRIMARY EXAMINER  
ART UNIT 2852

F L BRAUN/ac

10/03/03